

REMARKS

Claims 1-9, 11-17, 19 and 21-26 are pending. Claims 1 and 3 have been amended. Claim 27 has been added.

Claim Rejections – 35 U.S.C. § 112

The Examiner indicated that “the content” in line 8 of claim 1 and “said location” in line 1 of claim 3 lack sufficient antecedent bases. The Applicants have amended claims 1 and 3. In short, claim 1 was amended to change “the content” to “a content.” Claim 3 was amended to recite an introductory limitation that the “advertisements are based upon location related information of said wireless communication device.” The Applicants believe that these amendments overcome the Section 112 rejections.

Claim Rejections – 35 U.S.C. § 103

Claims 1-9, 11-17, 19 and 21-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Altschul et al. (5,983,094 hereinafter Altschul) in view of Goldhaber et al. (5,855,008 hereinafter Goldhaber) further in view of Titmuss et al. (WO 98/47295 hereinafter Titmuss). Claims 1 and 13 are independent claims. Claims 2-9, 11, 12, 21 and 22 depend from claim 1. Claims 14-17, 19, 23-26 depend from claim 13. The rejection of the foregoing claims is respectfully traversed for the following reasons.

Independent claim 1 is directed to a method of providing service in a wireless communication network. The steps include: providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network; providing products or services to said end user in response to a subscription to one of said service options; and providing **advertisements** to the end user **in lieu of** receiving compensation for the subscription, wherein the provision of the advertisements is based upon a content that a user is receiving on said wireless communication device.

Independent claim 13 is similar to claim 1 in that it recites the steps of providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network, providing products or services to said end

user in response to a subscription to one of said service options, and providing **advertisements** to the end user *in lieu of* receiving compensation for the subscription. However, in claim 13, the provision of the advertisements are based upon a configuration of the wireless communication device.

There exists a significant distinction in the art between Altschul and the presently claimed invention. Altschul is directed to a wireless telephone that can also serve as a credit card. Altschul describes a business model in which “the amount of paid airtime available through a wireless telephone is increased selectively and, in particular, is increased in proportion to the purchase amounts of selected purchases of goods and services through a purchase account, such as a credit card account.” [Altschul, Col. 1, lines 8-14] The patent repeatedly emphasizes that airtime is increased proportionally to the amount of credit card purchase. [See, e.g., Altschul, Col. 1, lines 36-39 (“provides wireless telephone users with increased airtime in proportion to the use of purchase accounts, such as credit card accounts”)] The purpose of the model is stated clearly in the patent: “the additional duration being in proportion to the purchase amounts made through the credit card account, thereby providing an incentive to use the credit card account identified in a magnetic strip 262 of the telephone 210.” [Altschul, Col. 6, lines 45-49] Thus, Altschul teaches a method directed to increasing the use of credit card purchases by providing an additional and proportional amount of “free” air-time.

Moreover, this “free” air-time described in Altschul is provided completely **independent** of (and in addition to) the subscribed periods of airtime charged by the telephone subscription service. [Altschul, Abstract (“enables the purchase amounts to be converted to additional periods of airtime during which telephonic communications are enabled independent of the subscribed periods of airtime”); Col. 5, lines 64-67 (“such purchases is converted into additional periods of airtime during which telephonic communication is enabled, independent of subscribed periods of airtime charged by the telephone subscription service”)]. Thus, the additional time is simply tacked on to existing subscription fees and calculated proportionally to provide a continued incentive to buy more products on the credit card account.

The model in Altschul is completely different from the one recited in the pending claims. First, Altschul does not teach or suggest providing any types of advertisements to the end user. Second, even if one tried to add the use of advertisements “in lieu of receiving compensation for the subscription,” the whole purpose of Altschul is removed – providing a continued incentive to use a credit card account. [Altschul, Col. 6, lines 45-49 (“the additional duration being in proportion to the purchase amounts made through the credit card account, thereby providing an incentive to use the credit card account identified in a magnetic strip 262 of the telephone 210.”)] Thus, the proposed combination in the Office Action would render Altschul unsatisfactory for its intended purpose. A proposed combination cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *see also In re Ratti*, 270 F.2d 810 (CCPA 1959) (the proposed combination cannot change the principle operation of a reference).

Moreover, Altschul actually teaches away from a method that provides advertisements *in lieu* of receiving compensation for the subscription. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). Altschul teaches that in exchange for credit card purchases, the model in Altschul provides users with increased airtime in proportion to the use of the credit card account. [Altschul, Col. 1, lines 36-39] The proportional amount of time added is done independent of subscribed periods of airtime charged by the telephone subscription service. [Altschul, Abstract and Col. 5, lines 64-67] Thus, Altschul teaches a continued incentive to use a credit card account by adding more time to an already existing service subscription and fee. Teaching away is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988).

Goldhaber and Titmuss fail to make up the deficiencies in Altschul. Goldhaber is directed to distributing advertising and other information over a computer network. The system described in Goldhaber provides a computer user with an incentive to view advertisements by providing “a ‘consumer interface button’ – for example, the image of

a little gold coin ('CyberCoin') next to each title on a list." [Goldhaber, Col. 5, lines 35-37, Fig. 11, Col. 16, lines 24-47] Selecting the associated CyberCoin icon initiates an interaction between the consumer's computer and an attention brokerage server storing the matching ad. [Goldhaber, Col. 16, lines 44-47] The patent states that the use of the consumer interface button – the "CyberCoin" – is innovative and unique in that it transfers real value to the computer user. [Goldhaber, Col. 5, lines 38-41] The patent further explains that this is a radical change in sponsorship in that "the advertisers have elected to sponsor the consumer who selects the CyberCoin – that is, they have chosen to pay the consumer directly for her attention rather than using the same funds for mass-market ad campaigns." [Goldhaber, Col. 5, lines 42-47]

The Office Action relies on Column 12, lines 5-14 and Col. 6, lines 20-27 of the Goldhaber reference to support the claim that the cited references may be combined and that the claims are obvious. It is respectfully submitted that the Office Action is reading too much into these statements in Goldhaber and that they, in effect, really support an important distinction between the claimed invention and the Goldhaber reference. Column 12, lines 5-14 refers to Figure 6 in Goldhaber where it states that advertisers (62) can directly compensate consumers (64) via payment (60(a)) for viewing and paying attention to their advertisements (68). It goes on to say that consumers (64) can use this payment (60(a)) to compensate information provider (6) via **another payment 60(b)** for providing entertainment or other information (70) the consumer wishes to access. The next sentence becomes important and highlights that Goldhaber requires a second payment – "[s]ponsorship becomes **unlinked** from the content of the sponsored entertainment or service 70, much to the benefit of the consumer." [Goldhaber, Col. 12, lines 12-14 (emphasis added)] Thus, Goldhaber teaches a **direct** payment to the computer user that is **unlinked** to the service provider. In contrast, the invention in claims 1 and 13 include the step of providing advertisements to the end user (in a wireless communication network) **in lieu of** receiving compensation for the subscription. Accordingly, the advertisements and the compensation of the subscription **are linked** in the claims. This is important because the present invention teaches a system or method that avoids a secondary payment being made by the user back to the service provider. Instead of a user having to make

a secondary payment to pay down or reduce an existing subscription fee, the present invention allows service operators to provide service options to individuals who might not ordinarily be able to afford typical subscription fees.

Titmuss describes a method of delivering information to mobile users in a telecommunication system. Titmuss does discuss the transfer of information based on the format type supported by a terminal. Titmuss, however, does not make up the deficiencies in Altschul and Goldhaber. For example, Titmuss has no description or suggestion of a system or method that provides **advertisements** to an end user *in lieu of* receiving compensation for the subscription. Titmuss is silent as to advertisements and how they could be provided to an end user in relation to compensation for subscription fees. In fact, it appears that Titmuss teaches that a fee is imposed for the system. [Titmuss, Page 21, lines 12-13 (“Each personal agent may periodically report use of the services available to a billing system for billing purposes.”)] Titmuss appears to be related to a much more complex system where a user has access to many types of terminals and the ability of the user to select or access information from those terminals depending on the file type.

In sum, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. Moreover, as discussed above, even if the cited references in the Office Action could be combined, the proposed combination would render at least Altschul unsatisfactory for its intended purpose and would change the principle operation of that reference. Thus, these references clearly fail, alone or in combination, to anticipate or render obvious the claims.

Claims 2-9, 11, 12, 21, 22 depend on independent claim 1. Claims 14-17, 19, 23-26 depend on independent claim 13. These dependent claims are believed to be allowable for at least the same reasons discussed above. See *In re Fine*, 837 F.2d

1071, 1076, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.). Some of these dependent claims are further discussed below.

With regard to claim 12, the Office Action does not specifically address the added limitations in claim 12. Claim 12 depends on claim 1, and recites that the step of providing advertisements further includes providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device. None of the cited references (Altschul, Goldhaber or Titmuss) discuss or make any mention of vehicle sensors much less advertisements based upon such vehicle sensors.

Claims 9 and 17 depends on claims 1 and 13, respectively, and recite that the step of providing advertisements further includes providing advertisements based upon advertisement acceptance. This is shown and described in the application with relation to Figure 7 where advertisement acceptance (558) is fed into an information pool so that the claimed method can provide advertisements based on such information. The Office Action cites a general knowledge in marketing and advertisement fields but fails to provide this specific feature in the wireless communication network as taught and claimed in the present application. Deficiencies of the cited references (Altschul, Goldhaber or Titmuss) cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art).

Claims 6 and 14 depend on claims 1 and 13, respectively, and recite that the method include a further step of requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service. The Office Action cites the Goldhaber reference. Goldhaber is distinguishable for the reasons set forth above. In particular, claims 1 and 13 (and reiterated in claims 6 and 14) require that the method include providing advertisements to the end user *in lieu of* receiving compensation for the

subscription. As described above, Goldhaber does not deal with wireless communication but teaches a **direct** payment to a computer user that is **unlinked** to the service provider. [Goldhaber, Col. 12, lines 11-14] In contrast, here, the claimed invention includes the steps of providing advertisements to the end user (in a wireless communication network) **in lieu of** receiving compensation for the subscription and requiring user interaction before being considered an advertisement that was provided **in lieu of** receiving compensation for the subscription. Accordingly, the advertisements and the compensation of the subscription **are linked**. This is important because the present invention teaches a system or method that avoids a secondary payment being made by the user back to the service provider. Instead of a user having to make a secondary payment to pay down or reduce an existing subscription fee, the claimed invention allows service operators to provide service options to individuals who might not ordinarily be able to afford typical subscription fees.

Claims 7 and 15 depend on claims 1 and 13, respectively. Claims 8 and 16 depend on claims 1 and 13, respectively. These claims recite that the step of providing advertisements comprises providing advertisements when a vendor has a product on an end user's shopping list and providing advertisements based upon a shopping history of the end user. The Office Action cites U.S. Patent No. 6,026,375 ("Hall") for the proposition that it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to include these features. Hall is directed to a method and system for processing orders from customers in a mobile environment. The customer initiates the order. [Hall, Col. 8, lines 47-50] Hall does not teach providing advertisements much less how to provide such advertisements in lieu of receiving compensation for a subscription for a wireless communication device. In Hall, a user places an order and the order is filled by checking local establishments.

Claims 11 and 19 depend on claims 1 and 13, respectively, and recite that the step of providing advertisements further includes providing advertisements at predetermined times based upon user device habits. The Office Action states that the combination of Altschul and Titmuss teaches that the personal agent accesses a customer database and retrieves information about customer's preferences to enable

the system to provide advertisements based on the customer's preferences. It is from this that the Office Action concludes that it would have been obvious to include in user's preference data a predetermined time when it would be convenient to receive advertisements based on user's habits. First, as explained above, the combination of Altschul and Titmuss to make the present invention would render Altschul unsatisfactory for its intended purpose and would change the principle operation of that reference. Second, although Titmuss discusses a database, Titmuss does not teach how this applies to sending advertisements over a wireless communication network. The page in Titmuss cited in the Office Action (page 19) discusses a personal agent that checks whether the summary of the information source contents corresponds with any of the users preferences. The suggested user preferences are listed on page 14 of Titmuss. None of the suggested user preferences talks about the willingness to accept advertisements or providing such advertisements at predetermined times based upon user device habits.

The Applicants respectfully request withdrawal of the obviousness rejection based on these references.

New Claims

The Applicants have added claim 27. Claim 27 has the same limitations as claim 13 but with the additional limitations recited in claim 12. Claim 27 is directed to method where the wireless communication device is in a vehicle. The method includes, among other things, the step of providing advertisements to the end user in lieu of receiving compensation wherein the advertisements are based upon the status of sensors in a vehicle incorporating the wireless communication device. For the same reasons set forth above in relation to claims 13 and 12, claim 27 is believed to be allowable.

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Attached hereto is a mark-up version of the changes made to the claims by the current amendment. The attached pages are captioned "**Version with Markings to Show Changes Made.**"

It is the Applicants' belief that the pending claims are now in condition for allowance, and action towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.


Please charge any fees associated herewith, including extension of time fees, to 13-4772

Respectfully submitted,

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Version with Markings to Show Changes Made

Claims 1 and 3 have been amended as follows:

1. (Thrice Amended) A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options; and

providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon [the] a content that a user is receiving on said wireless communication device.

3. (Thrice Amended) The method of claim 1 wherein the advertisements are based upon location related information of said wireless communication device, said location related information includes at least one of the following:

position, direction, or speed.

Claim 27 has been added as follows:

27. (New) A method of providing service in a wireless communication network comprising the steps of:

- providing a plurality of service options to an end user of a wireless communication device in a vehicle operating on said wireless communication network;

- providing products or services to said end user in response to a subscription to one of said service options; and

- providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a configuration of said wireless communication device and the advertisements are based upon a status of sensors in the vehicle incorporating said wireless communication device.